

RECEIVED
CENTRAL FAX CENTER

FEB 14 2008

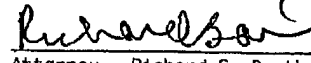
**IN THE UNITED STATES PATENT
AND TRADEMARK OFFICE**

Serial No. : 09/925,673
Applicants : Masakatsu KANEKO et al.
Filed : August 9, 2001
For : NOVEL NUCLEOSIDE AND
OLIGONUCLEOTIDE ANALOGUES
Art Unit : 1623
Examiner : Ganapathy KRISHNAN
Docket No. : 01376CIP/HG
Confirm. No.: 4630
Customer No.: 01933

CERTIFICATE OF FACSIMILE
TRANSMISSION
PTO NO. 1-571-273-8300

TOTAL PAGES: 11

I hereby certify that this
paper is being facsimile
transmitted to the
Commissioner for Patents
on the date noted below.


Attorney: Richard S. Barth

Dated: February 14, 2008

In the event that this Paper
is late filed, and the
necessary petition for
extension of time is not filed
concurrently herewith, please
consider this as a Petition
for the requisite extension of
time, and to the extent not
tendered by Form PTO-2038
attached hereto, authorization to
charge the extension fee,
or any other fee required
in connection with this
Paper, to Account No. 06-1378.

**REQUEST FOR RECONSIDERATION
OF DECISION ON APPLICATION
FOR PATENT TERM ADJUSTMENT**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

MAIL STOP PETITION

S I R :

This is a request for reconsideration of the DECISION ON
APPLICATION FOR PATENT TERM ADJUSTMENT dated January 4, 2008
(hereinafter referred to as "the January 4, 2008 DECISION") in
the above-identified patent application.

The January 4, 2008 DECISION dismissed applicants'
APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR
RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN NOTICE OF

ALLOWANCE (37 CFR §1.705) filed September 6, 2007 (hereinafter referred to as the "APPLICATION FOR PTA").

In the APPLICATION FOR PTA, applicants requested to be afforded a patent term adjustment of 473 days, i.e., 278 days under 37 CFR 1.702(a)(2), in addition to the 195 days indicated in the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) that was attached to the USPTO Notice of Allowance and Fee(s) Due mailed July 26, 2007.

I. The Facts

A. In reply to the Corrected Notice of Allowance and Fee(s) Due mailed April 5, 2005 (which required that the Issue Fee be paid by July 5, 2005), the Issue Fee for the above-identified application was paid on June 27, 2005.

B. The USPTO issued a "NOTICE OF WITHDRAWAL FROM ISSUE UNDER 37 CFR 1.313(c) (undated, but mailed on June 22, 2006) (hereinafter referred to as the "NOTICE OF WITHDRAWAL").

The NOTICE OF WITHDRAWAL erroneously stated that the Issue Fee had not been paid. As noted hereinabove, the Issue Fee was paid on June 27, 2005.

The NOTICE OF WITHDRAWAL erroneously stated that the withdrawal was under 37 CFR 1.313(c) (i.e., upon petition by

applicants). As pointed out in applicants' LETTER RE: NOTICE OF WITHDRAWAL FROM ISSUE filed July 11, 2006, the application was withdrawn from issue by the initiative of the USPTO and therefore under 37 CFR 1.313(b), not 37 CFR 1.313(c).

C. An Office Action dated August 1, 2006 rejected claims 2, 4, 5 and 6 under 35 USC 112, second paragraph; and under 35 USC 102 and 35 USC 103, rejected claims 1-7, 37-45, 55, 62-65, 70, 72, 76 and 111 over disclosure in the specification of USP 6,794,499 to Wengel et al.

D. An AMENDMENT UNDER 37 CFR 1.111, which (i) made minor editorial corrections to several claims and (ii) which traversed said rejections under 35 USC 102, 35 USC 103 and 35 USC 112, was filed November 8, 2006. A FINAL rejection was mailed February 7, 2007, which withdrew the 35 USC 112 rejection and again rejected all of the claims under 35 USC 102 and 35 USC 103 over said Wengel et al. USP 6,794,499. A RESPONSE UNDER 37 CFR 1.116 was filed May 7, 2007, which did not amend claims, but instead traversed the rejections under 35 USC 102 and 35 USC 103 (the only remaining rejections). A Notice of Allowance and Issue Fee(s) Due was mailed July 26, 2007. An Issue Fee Transmittal was mailed to the USPTO on September 27, 2007. The patent has

not yet issued on the above-identified application. An ISSUE NOTIFICATION dated February 6, 2008 states that the patent (USP 7,335,765) will issue on February 26, 2008. Since February 26, 2008 is four months and thirty days from the submission of the Issue Fee on February 24, 2007, applicants are entitled to an additional thirty days of PTA, which has been accorded by the USPTO. The ISSUE FEE NOTIFICATION provides 225 days of PTA, whereas the September 26, 2007 Determination of Patent Term Adjustment provided 195 days of PTA.

E. USP 6,794,499 to Wengel et al. was cited in applicants' INFORMATION DISCLOSURE STATEMENT filed February 17, 2005 (hereinafter referred to as the "February 17, 2005 IDS"). In the February 17, 2005 IDS, it was stated that USP 6,794,499 B2 issued from application Serial No. 09/152,059, and that US 2002/0068708 A1 (the published application of Serial No. 09/152,059) was cited in applicants' INFORMATION DISCLOSURE STATEMENT filed August 17, 2004. USP 6,794,499 B2 and US 2002/0068708 A1 are hereinafter referred to collectively as "Wengel et al."

Said August 17, 2004 INFORMATION DISCLOSURE STATEMENT BY APPLICANT also identified USP 6,670,461 B1; US 2003/0134808 A1 and US 2003/0144231 A1, which are patent family members with the aforescribed Wengel et al. USP 6,794499 B2 and US 2002/0068708

A1, and all these U.S. patent documents should have the same specification and disclose the same subject matter relied upon in the rejection of claims under 35 USC 102 and 35 USC 103 in the August 1, 2006 Office Action. The Examiner considered and made of record said August 17, 2004 and February 17, 2005 Information Disclosure Statements by initialing each cited publication.

It is therefore respectfully submitted that the USPTO unduly delayed in for the first time applying the Wengel et al. specification to reject the applicants' claims in the August 1, 2006 Office Action, after the USPTO withdrew the above-identified application from issue more than a year after applicants paid the Issue Fee on June 27, 2005.

F. Applicants' APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN NOTICE OF ALLOWANCE (37 CFR §1.705) was filed September 6, 2007 and presented reasons for adjustment of the term based upon 35 USC 154(b)(1)(A)(ii) and 37 CFR 1.702(a)(2).

G. Said APPLICATION FOR PATENT TERM ADJUSTMENT was dismissed in the DECISION ON APPLICATION FOR PATENT TERM ADJUSTMENT dated January 4, 2008. On page 2, lines 10 to 11 in the January 4, 2008 DECISION, it is stated "First of all, the

relevant section to consider is 37 CFR 1.702(a)(4), not (a)(2)."

No reason was given in the January 4, 2008 DECISION why 37 CFR 1.702(a)(2) was not the relevant section. Thereafter, the January 4, 2008 DECISION was made based on 37 CFR 1.702(a)(4).

II. Applicable Law and Rules

A. Introduction

It is respectfully submitted that 37 CFR 1.702(a)(2) (and its corresponding section in the statute (35 USC 154(b)(i)(A)(ii)) serves as a basis to provide the correction of the patent term adjustment requested herein. Since 37 CFR 1.702(a)(4) was considered in the January 4, 2008 DECISION, such section is discussed hereinbelow as an alternate basis for adjustment of patent term.

B. 35 USC 154(b)(i)(A)(ii); 37 CFR 1.702(a)(2)

35 USC 154(b)(i)(A)(ii) refers to delays due to the failure of the Patent and Trademark Office to

"(ii) respond to a reply under section 132...within 4 months after the date on which the reply was filed."

35 USC 132(a) provides as follows:

"Whenever, on examination, any claim for a patent is rejected, or any objection or **requirement** made, the Direction shall notify the applicant thereof, stating

the reasons for such rejection, or objection or **requirement.**" (emphasis added)

The Corrected Notice of Allowance and Fee(s) Due mailed April 5, 2005 required that the Issue Fee be paid by July 5, 2005. In reply thereto, the Issue Fee was paid by applicants on June 27, 2005.

The USPTO failed to respond within four months of the aforesaid payment of the Issue Fee on June 27, 2005, as required by 37 CFR 1.702(a)(2) ("Respond to a reply under 35 USC 132..."). The payment of the Issue Fee on June 27, 2005 is respectfully submitted to have been made in compliance with a "requirement" under 35 USC 132(a), i.e., the requirement to pay the Issue Fee. The USPTO did not respond to the aforesaid June 27, 2005 payment of the Issue Fee until the mailing of the August 1, 2006 Office Action.

It is therefore respectfully requested that applicants be afforded a 278 USPTO delay from four months after the payment of the Issue Fee on June 27, 2005 to the mailing date of the August 1, 2006 Office Action.

Taking the above into consideration, the correct patent term adjustment under 37 CFR 1.702 is 503 days (195 days + 278 days plus 30 days for the delay in issuing USP 7,335,765 on February 26, 2008 for a total of 503 days).

The DECISION ON APPLICATION FOR PATENT TERM ADJUSTMENT, referring to applicants' arguments for time under 37 CFR 1.702(a)(2) stated:

"Applicants' arguments have been considered, but not found persuasive. First, of all, the relevant section to consider Office delay is 1.702(a)(4), not (a)(2)."

As noted hereinbefore, no reason(s) were given as to why §1.702(a)(2) was not the relevant section.

C. 35 USC 154(b)(1)(A)(iv); 37 CFR 1.702(a)(4)

Applicants did not refer to 37 CFR 1.702(a)(4) in their APPLICATION FOR PTA, since at that time it was considered that it was premature to rely on 37 CFR 1.702(a)(4) because a patent had not yet issued (and to date, a patent has still not issued; as noted hereinabove, the ISSUE NOTIFICATION dated February 6, 2008 stated that a patent will issue on February 26, 2008).

Since the January 4, 2008 DECISION was decided on the basis of 37 CFR 1.702(a)(4), to avoid any possible estoppel, applicants assert 37 CFR 1.702(a)(4) (and 35 USC 154(b)(1)(A)(iv)) as an alternate basis for requesting additional days of patent term adjustment; subject to the requirement that such an APPLICATION FOR PTA based on 37 CFR 1.702(a)(4) becomes timely on the date that the patent issues upon the above-identified application. Therefore, the additional patent term adjustment should be

determined based on the payment of the Issue Fee which was paid on June 27, 2005.

D. Rebuttal of The Reason For Dismissal Stated
In the January 4, 2008 DECISION

35 USC 159(b) (i) (A) (iv) refers to delays, due to the failure of the Patent and Trademark Office to

"(iv) issue a patent within 4 months after the date on which the Issue Fee was paid under section 151 and all outstanding requirements were satisfied."

At the bottom of page 2 of the January 4, 2008 DECISION, the following was quoted from 65 Fed. Reg. 54366 dated September 18, 2000:

"the date the issue fee was paid and all outstanding requirements were satisfied is the later date of the date the issue fee was paid or the date all outstanding requirements were satisfied. However, if prosecution in an application is reopened after allowance (see MPEP 1308), all outstanding requirements are not satisfied until the application is again in condition for allowance as indicated by the issuance of a new notice of allowance under 35 U.S.C. 151 (see MPEP 1308)."

It is respectfully submitted that the above quote represents only a comment in an OG Notice and is not supported by a statute, a PTO rule, a cited precedent or a MPEP provision. Moreover, such quoted passage does not distinguish between a withdrawal from issue on the initiative of the USPTO (as in the case at hand) or a withdrawal from issue based on an applicant's

petition. It is therefore respectfully submitted that the above quote is not relevant with respect to the case at hand.

Applicants respectfully disagree with the contention in the first sentence on page 3 of the January 4, 2008 DECISION that "the date of payment of the issue fee on June 27, 2005 is not controlling." As discussed above, the withdrawal from issue on June 22, 2006 was at the initiative of the USPTO. It is respectfully submitted that the start of the USPTO delay under 37 CFR 1.702(a)(4) should be determined based on the payment of the Issue Fee on June 27, 2005, and not when a subsequent Issue Fee transmittal was submitted on September 27, 2007.

Although the patent on the above-identified application has not yet issued (as noted hereinabove, the patent should issue on February 26, 2008), the patent will not issue within four months of applicants' payment of the Issue Fee on June 27, 2005 (when all the outstanding requirements were satisfied). Accordingly, applicants seek patent term adjustment under 37 CFR 1.704(a)(4).

E. Alternate basis for PTA under
35 USC 154(b)(i)(A)(ii); 37 CFR 1.702(a)(2)

It is considered that a rationale for the position stated in the 65 Fed. Reg. 54366 statement quoted in Section II.D. and quoted hereinbefore that if prosecution in an application is reopened after allowance "...all outstanding requirements are not satisfied until the application is again in condition for

allowance..." would be that the earlier issued Notice of Allowance and Issue Fee(s) Due was void *ab initio*. Based on the rationale discussed herein and assuming that the Corrected Notice of Allowance and Issue Fee(s) Due mailed April 5, 2005 was void *ab initio*, the term of delay under subsection 37 CFR 1.702(a)(2) would start 4 months after applicants completed the requirements which placed the application in condition for allowance prior to April 5, 2005.

III. Conclusion

Reconsideration and the granting of the additional days of patent term adjustment as requested herein are respectfully requested.

If any fees are required in connection with this paper, please charge such fees to Account No. 06-1378.

Frishauf, Holtz, Goodman
& Chick, P.C.
220 Fifth Ave., 16th Floor
New York, NY 10001-7708
Tel. No.: (212) 319-4900
Fax No.: (212) 319-5101

Respectfully submitted,



Richard S. Barth
REG. NO. 28,180

E-Mail Address: BARTH@FHGC-LAW.COM
RSB/ddf